

Patent Docket P1123R1D1
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Henry B. Lowman et al. Serial No.: 09/716,028 Filed: November 17, 2000 For: Therapeutic Compositions Comprising Anti-IgE Antibodies and Immunosuppressive Agent	Group Art Unit: 1644 Examiner: G. Ewoldt Confirmation No: 7056 CUSTOMER NO: 09157 CERTIFICATE OF FACSIMILE TRANSMISSION I hereby certify that this correspondence is being sent via facsimile to Commissioner of Patents and Trademarks, Washington, DC 20231, at facsimile number 703-305-3014 on. August 7, 2003 By: <u>Ann Savelli</u> Ann Savelli
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COMMUNICATION

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir,

Further responsive to the Final Action mailed November 12, 2002 and the Notice of Appeal filed February 12, 2003, in light of a telephone interview on August 5, 2003 between the undersigned and Examiner Ewoldt in which the allowability of the claims were discussed, Applicants hereby file a Terminal disclaimer over U.S.P. 5,994,511 and a petition for a four month extension of time.

Respectfully submitted,
GENENTECH, INC.

Date: August 7th 2003

By: Craig G. Svoboda
Craig G. Svoboda
Reg. No. 39,044
Telephone No. (650) 1489

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of LOWMAN <i>et al.</i> Serial No.: 09/716,028 Filed: November 17, 2000 For: <i>Therapeutic Compositions Comprising Anti-IgE Antibodies and Immunosuppressive Agent (as amended)</i>	Group Art Unit: 1644 Examiner: G. Ewoldt Confirmation No.: 7056 Customer No.: 09157 <div style="text-align: center;">CERTIFICATE OF FACSIMILE TRANSMISSION I hereby certify that this correspondence is being sent via facsimile to Commissioner of Patents and Trademarks, Washington, DC 20231, at facsimile number 703-305-3014 on August 7, 2003 By: <i>Ann Savelli</i> Ann Savelli</div>
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TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A PRIOR PATENT

Mail Stop AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Your petitioner, Genentech, Inc., having a place of business at 1 DNA Way, South San Francisco, California 94080-4990 in the county of San Mateo has reviewed the evidentiary documents set forth hereinbelow and certifies to the best of Genentech's knowledge and belief that title in and to the herein application and in the referenced U.S. Patent No. 5,994,511 reside in Genentech, Inc.

Your petitioner, Genentech, Inc., represents that it is the owner of the entire right, title, and interest in and to application U.S. Serial No. 09/716,028, filed November 17, 2000, by virtue of an assignment recorded on October 20, 1998 at Reel 9543, Frame 0159, and is also the owner of the entire right, title and interest in and to U.S. Patent No. 5,994,511, filed July 2, 1997 and issued

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November 30, 1909, by virtue of an assignment recorded on May 15, 1998 at Reel 9226, Frame 0634.

Your petitioner hereby disclaims the terminal part of any patent granted on the herein application Serial No. 09/716,028 that would extend beyond the expiration date of the full statutory term as presently shortened by any terminal disclaimer of said Patent Nos. 5,994,511, and hereby agrees that any patent so granted on the herein application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent Nos. 5,994,511, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term as presently shortened by any terminal disclaimer of Patent Nos. 5,994,511 in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above. Petitioner reserves the right to extend the shortened term of any patent granted on the above-identified application due to regulatory delays pursuant to 35 U.S.C. §156.

I am an attorney of record and empowered to act on behalf of Genentech, Inc. as an attorney of the company.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

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The Commissioner is authorized to charge the statutory fee of \$110 required for filing this Disclaimer to Deposit Account No. 07-0630. Please charge any deficiency or credit any overpayment to Account 07-0630. A duplicate of this sheet is enclosed.

Respectfully submitted,

GENENTECH, INC.

Date: August 7, 2003

By: Craig G. Svoboda

Craig G. Svoboda

Reg. No. 39,044

Telephone No. (650) 225-1489